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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/003,446	10/26/2001	Shigco Yoshida	11283-015001 / PH-1269US	7360
26211	7590	12/28/2004	EXAMINER	
FISH & RICHARDSON P.C. CITIGROUP CENTER 52ND FLOOR 153 EAST 53RD STREET NEW YORK, NY 10022-4611			MARSCHER, ARDIN H	
			ART UNIT	PAPER NUMBER
			1631	

DATE MAILED: 12/28/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/003,446

Applicant(s)

YOSHIDA ET AL.

Examiner

Ardin Marschel

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 14 June 2004 and 04 October 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-25 is/are pending in the application.
- 4a) Of the above claim(s) 9-25 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-8 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☒ Claim(s) 1-25 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

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DETAILED ACTION

Applicants' arguments, filed 6/14/04 and 10/4/04, have been fully considered but they are not deemed to be persuasive. Rejections and/or objections not reiterated from previous office actions are hereby withdrawn. The following rejections and/or objections are either reiterated or newly applied. They constitute the complete set presently being applied to the instant application.

PRIOR ART

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claims 1-4, 6, and 7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Vijg et al. (P/N 5,068,176); taken in view of the legal decision of In re Venner [262 F.2d 91,95, 120 USPQ 193, 194 (CCPA 1958)].

This rejection is maintained and reiterated from the previous office action, mailed 3/11/04. Applicants argue firstly that no information regarding sequences of analyzed DNA is utilized for any purpose, let alone for generating a control 2-D electrophoretic

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pattern. In response Vijg et al. clearly utilizes sequence information as part of the analyzing of 2-D electrophoretic patterns as cited in numerous citations in the pointed to section in Vijg et al. in column 4, line 31, through column 8, line 68, wherein, for example, restriction fragments which are defined by sequences therein are related to spots for analysis thus deducing a pattern as required in instant claim 1, lines 2-3. Thus, this argument is contrary to the factual basis for this rejection pointed to in Vijg et al. and therefore non-persuasive. Applicants also argue that the control 2-D electrophoretic pattern in the instant claims is generated as a "virtual" control pattern without "actual" pattern production. No virtual control limitation is seen in the above listed instant claims. Applicants may intend that the "deduced by" wording in instant claim 1, lines 2-3, is a virtual limitation. In response the above relating of spots to restriction fragments, for example, in the reference is reasonably a type of "deduced by" practice directed to pattern production. The spot pattern is deduced by restriction fragment sequence information in Vijg et al. to result in a control pattern of spots plus related restriction fragments with their corresponding sequences. This argument therefore is not directed to distinguishing claim limitations but is directed to a "virtual" limitation which is not present in the above listed instant claims and therefore is non-persuasive. Applicants then argue that the subject matter of In re Venner is not comparable to the instant invention in that the step which is controlled in the decision of In re Venner is identical to that in prior art apparatuses but performed automatically rather than manually. In response the automation of manual activities in the reference by merely automatically controlling the processes is also what is performed to relate Vijg

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et al. via In re Venner to the instant invention and does fit the fact pattern of In re Venner contrary to applicants' argument.

Claims 1-8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Vijg et al. (P/N 5,068,176); taken in view of the legal decision of In re Venner [262 F.2d 91,95, 120 USPQ 193, 194 (CCPA 1958)]; taken further in view of Stevens et al. (P/N 5,776,767).

This rejection is maintained and reiterated from the previous office action, mailed 3/11/04. Applicants argue this rejection for reasons as already responded to above and are equivalently non-persuasive here. Applicants further argue that instant claims 5 and 8 have additional indicia of non-obviousness. Reconsideration of instant claim 5 and 8 reveals that they are directed to sequence information communication over a network and memorizing information relating electrophoretic spots to abnormal information. These limitations were described in the previous office action, mailed 3/11/04, as being present in Stevens et al. and motivated and suggested to be combined with Vijg et al. and In re Venner due to the desire to detect a disease via sequence variations which are abnormal. Citations supporting the presence of these limitations were pointed to in said previous office action. Applicants' allegations that Stevens et al. lack support for these limitations are only allegations without factual support nor do they negate any of the specific factual support pointed to in Stevens et al. and therefore are non-persuasive as not being directed to said bases of the rejection. This rejection also is based on the combination of references and not on In re Venner alone nor even Vijg et al. alone and thus applicants additional argument that In re Venner does not teach communications

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over a network or sequence data memorization lacks recognition that In re Venner was not utilized for teaching these limitations but rather Stevens et al. was. This argument is therefore not directed to the basis of the rejection and therefore non-persuasive.

No claim is allowed.

THIS ACTION IS MADE FINAL. Applicants are reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

This application contains claims 9-25 drawn to an invention nonelected without traverse in the Paper filed 12/29/03. A complete reply to the final rejection must include cancellation of nonelected claims or other appropriate action (37 CFR 1.144) See MPEP § 821.01.

Papers related to this application may be submitted to Technical Center 1600 by facsimile transmission. Papers should be faxed to Technical Center 1600 via the Central PTO Fax Center. The faxing of such papers must conform with the notices published in the Official Gazette, 1096 OG 30 (November 15, 1988), 1156 OG 61 (November 16, 1993), and 1157 OG 94 (December 28, 1993)(See 37 CFR § 1.6(d)). The Central PTO Fax Center number is (571) 273-8300.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ardin Marschel, Ph.D., whose telephone number is (571) 272-0718. The examiner can normally be reached on Monday-Friday from 8 A.M. to 4 P.M.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Woodward, Ph.D., can be reached on (571) 272-0722.

Any inquiry of a general nature or relating to the status of this application should be directed to Legal Instrument Examiner, Tina Plunkett, whose telephone number is (571) 272-0549.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

December 27, 2004

Ardin H. Marschel 12/27/04
ARDIN H. MARSCHEL
PRIMARY EXAMINER